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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,973	08/22/2003	Joel A. Becker	TIG-001	1062
33297	7590	06/30/2006	EXAMINER	
BEEM PATENT LAW FIRM 53 W. JACKSON BLVD., SUITE 1352 CHICAGO, IL 60604-3787			LEE, CYNTHIA K	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/646,973	Applicant(s) BECKER, JOEL A.	
	Examiner Cynthia Lee	Art Unit 1745	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 7,8 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species:

- I. A battery carrier as depicted in Fig. 1-4, with rotatable panels
- II. A battery carrier as depicted in Fig. 5-6, with collars

The species are independent or distinct because they have different mechanical/functional means or characteristics or as set forth above (see MPEP 809.02(a)). Accordingly, each species requires a different field of search (see MPEP 808.02). Thus, there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required.

Restriction for examination purposes as indicated above is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Mr. Roger French on 5/9/2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6 and 9-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 8, 13-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Information Disclosure Statement***

An Information Disclosure Statement (IDS) has not been filed as of the mailing of this Office Action.

#### ***Drawings***

The drawings received 8/22/2003 are acceptable for examination purposes.

#### ***Claims Analysis***

The Office notes that the recitation "means associated with the housing for securing the carrier to a surface of an article" in claims 1 and 9 does not properly invoke 35 USC 112, 6<sup>th</sup> paragraph because it does not meet the first prong of the three-prong test. See MPEP 2181.

The Office notes that the recitations "means associated with the housing for securing the carrier to a surface of an article comprises a strip of adhesive material extending along the lower surface of the bottom wall" in claim 6 and "means associated with the housing for securing the carrier to a surface of an article comprises a strip of adhesive material secured to the lower surface of the bottom plate" in claim 12 do not

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properly invoke 35 USC 112, 6<sup>th</sup> paragraph because it does not meet the first and third prong of the three-prong test. See MPEP 2181.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "generally" is a relative term which renders the claim indefinite. The term "generally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Halaburda (US 5462161).

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Halaburda discloses a container containing a bottom wall (30) and side walls (20) with parallel elongate grooves (30). The side walls contain hinges (40 and 40A) that rotate about the bottom. The side walls (20) abut against the ends of the batteries. Halaburda's container comprises a pair of spaced-apart elongate parallel receptacles extending along the length of the bottom plate, the side wall at each end of the bottom plate defining two panels each having an inwardly bent ear portion, the clip at each end of the housing being located between the panels.

Thus, claims 1-5 and 9-11 are anticipated by Halaburda.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye in view of Lake (US 6543615).

Kaye discloses a carrier comprising a housing and side walls at each end of the bottom plate rotatable between a first position generally parallel to the upper surface of the bottom plate and a second position normal to the bottom plate.

Kaye does not disclose a securing means. However, Lake teaches a securing means that firmly grips writing implements (see fig. 1). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a holder in Kaye's battery carrier.

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Kaye does not disclose an adhesive material. However, Lake teaches that the writing implement holder can be secured with an adhesive added to the underside to be mounted wherever the user deems practicable (2:10-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an adhesive to Kaye's battery carrier for the benefit of mounting the battery carrier on the wall.

Kaye and Lake are related arts pertinent to holding means and thus, the combination is proper.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



PATRICK JOSEPH RYAN  
SUPERVISORY PATENT EXAMINER

ckl

Cynthia Lee

Patent Examiner